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10/736,339	12/15/2003	Rajesh K. Saini	2001-IP-005484U1P1	3700
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ROBERT A. KENT P.O. BOX 1431 DUNCAN, OK 73536			EXAMINER LIGHTFOOT, ELENA TSOY	
			ART UNIT 1715	PAPER NUMBER
			NOTIFICATION DATE 08/20/2010	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Advisory Action

The amendment filed on August 12, 2010 under 37 CFR 1.116 in reply to the final rejection has been entered and considered but is not deemed to place the application in condition for allowance for the reasons of record set forth in the Final Office Action mailed on June 30, 2010.

Response to Arguments

Applicant's arguments filed August 12, 2010 have been fully considered but they are not persuasive.

i. The References Do Not Disclose "Combining an Acid-Releasing Degradable Material With a Solvent or a Plasticizer to Create a Coating Solution"

Applicants' submit that Nguyen, Lee, and Still do not disclose "combining an acid-releasing degradable material with a solvent or a plasticizer to create a coating solution" as required by independent claim 42, or "combining an acid-releasing degradable material with a plasticizer to create a coating solution" as required by independent claim 55. With respect to Nguyen, the Examiner does not dispute this fact but rather indicates that Nguyen discloses that a liquid or solution of a tackifying compound can contain a solvent. See Final Office Action at 3. The Examiner separately argues that the treatment chemical in Nguyen is the equivalent of the acid-releasing degradable material of the present application. Nguyen would therefore need to disclose that the treatment chemical, not the liquid or solution of a tackifying compound, is combined with a solvent and/or plasticizer to disclose the limitation in independent claims 42 and 55. In rebuttal in the Final Office Action, the Examiner argues that the liquid or solution of tackifying compound can contain a solvent, and that the treatment chemical can be introduced in a similar manner. Final Office Action at 3. Thus, the treatment chemical may be introduced in a solution with a suitable solvent. *Id.* Applicants respectfully disagree. Nguyen discloses two distinct particulates: 1) a particulate material such as a proppant and 2) a "treatment chemical which may be in particulate form or coated upon or in a substrate." Nguyen at col. 3, II. 43-45. Specifically, the second type of particulate comprises a "porous or non-porous substrate upon which a treatment chemical is either absorbed or coated or even particulates or agglomerates of particles of a desired solid treatment chemical which exhibits solubility in the formation fluids upon contact therewith." Nguyen at col. 4, II. 32-36. Thus, the treatment chemical is a distinct component that is in a particulate form.

The Examiner respectfully disagrees with this argument. First of all, Nguyen's teaching at col. 3, II. 43-45 "2) a treatment chemical which **may be** in particulate form or coated upon or

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in a substrate", can be interpreted that a particulate form of a treatment chemical is *optional*.

Second, at col. 4, lines 31-40, Nguyen teaches:

“Surprisingly, it has been found that the *additional material* also may comprise porous or non-porous substrates upon which a treatment chemical is either absorbed or coated **or even particulates** or agglomerates of particles of a desired solid treatment chemical which exhibits solubility in the formation fluids upon contact therewith. The additional material **may** or may not function as a proppant or gravel pack material in the subterranean formation, depending upon the presence or absence of a substrate and its properties.”

Thus, Nguyen’s teaching at col. 4, II. 32-36 "porous or non-porous substrate upon which a treatment chemical is either absorbed or coated **or even particulates** or agglomerates of particles of a desired solid treatment chemical which exhibits solubility in the formation fluids upon contact therewith" should be interpreted that particulates of solid treatment chemical are *optional*, and non-particulate treatment chemical may be coated on porous or non-porous substrate which may function as proppant.

Therefore, in contrast to Applicants’ assertion, Nguyen is not limited to the particulate form of the treatment chemical.

As to combining treatment chemical with a solvent, Applicants disagrees with the Examiner that Nguyen’s teaching “the treatment chemical can be introduced in a similar manner” implies solvent. However, incorporation of a carrier or diluent was held to have been obvious. *In re Lerner* 169 USPQ 51 (CCPA 1971); *In re Rosicky* 125 USPQ 341 (CCPA 1960).

Therefore, combining treatment chemical with a solvent would be obvious over Nguyen whether or not Applicants agrees with the Examiner that Nguyen’s teaching “the treatment chemical can be introduced in a similar manner” implies solvent.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ELENA Tsoy LIGHTFOOT whose telephone number is (571)272-1429. The examiner can normally be reached on Monday-Friday, 9:00AM - 5:30 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571-272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Elena Tsoy Lightfoot, Ph.D.
Primary Examiner
Art Unit 1715

August 17, 2010

/Elena Tsoy Lightfoot/